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Dated: October 9, 2007
Electronic Signature for Shelley C. Danek, Ph.D.: /Shelley C. Danek - #57,712/

Docket No.: 19036/40796
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Yuka Matsui

Application No.: 10/561,629

Confirmation No.: 8420

Filed: (national stage application of
PCT/JP2004/008710, filed June 21, 2004)

Art Unit: Not Yet Assigned

For: OPHTHALMIC COMPOSITION

Examiner: Not Yet Assigned

RENEWED PETITION UNDER 37 CFR 1.47(B) AND
NEW PETITION UNDER 37 CFR 1.59(B)

MS PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Decision on assignee's petitions under 37 CFR 1.47(b), 1.183, and 1.182, mailed June 11, 2007, the assignee submits the following renewed petition under 37 CFR 1.47(b). The Decision dismissed the assignee's petitions and set a two month extendable period within which to request reconsideration. This renewed petition is timely filed as it is accompanied by a petition for an extension of time and an authorization to charge Deposit Account No. 13-2855 for a two-month extension of time. Reconsideration is requested.

Except as explained herein, the assignee continues to rely on material filed in support of the original petition and incorporates such material herein by reference.

The Decision to dismiss assignee's initial petition cited six requirements for a petition under 37 CFR 1.47(b): (1) the petition fee; (2) factual proof of the inventor's refusal to sign the declaration or of diligent effort to reach an unavailable inventor; (3) a statement of last known address of the inventor; (4) an oath or declaration by the 37 CFR 1.47(b) applicant

on behalf of or as agent for the non-signing inventor; (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application; and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. The Decision on Petition Under 37 CFR 1.47(b) stated that items (1) and (6) have been met (and no additional petition fee is due with this request) but alleged that items (2)-(5) have not. This paper presents further support for items (2)-(5) and it is respectfully requested that this renewed petition under 37 CFR 1.47(b) be granted.

Submitted herewith is further proof of the inventor's refusal to sign the inventor's declaration after receipt of all application papers and the declaration. Two Declarations of Fact are enclosed, by Ms. Naoka Harada (Appendix 1) and Ms. Yasuyo Yamaguchi (Appendix 2). Ms. Harada attests to the fact that she personally delivered to inventor Matsui a copy of the application papers and the inventor's declaration on April 30, 2006. Ms. Yamaguchi attests to the fact that she had a conversation with inventor Matsui via telephone on August 30, 2006 regarding the unexecuted declaration. During this conversation, Ms. Matsui told Ms. Yamaguchi that she refused to sign the declaration.

To satisfy item (3), the assignee submits the following address as the last known mailing address for inventor Matsui:

14-38, Chitose-cho,
Shimizu-ku, Shizuoka-shi,
Shizuoka 424-0828
JAPAN

Previous discussion concerning Japanese privacy laws is rendered moot with respect to item (3), as the assignee has obtained and can provide the above mailing address for Ms. Matsui, without violating Japanese privacy laws.

Regarding item (4), assignee submits an inventor's declaration, signed by Mr. Yutaka Kobayashi, President and Chief Operating Officer (COO) of Kobayashi Pharmaceuticals Co., Ltd. (Appendix 3), who signed the declaration on behalf of and as an agent for the inventor, in his capacity as President and COO of the assignee.

In support of a showing of sufficient proprietary interest for item (5), the assignee submits a translation of Japanese Application No. 2003-176965, filed June 20, 2003

(Appendix 4), as requested by the Petitions Office in its Decision. As demonstrated in the original petition, Inventor Matsui assigned all of her intellectual property rights throughout the world, including her rights to obtain patents, to Kobayashi Pharmaceutical with respect to Japanese Application No. 2003-176965 and the invention titled "Ophthalmic Composition" described therein. The assignment has been recorded with the U.S. Patent Office at Reel/Frame No. 018868/0382. The current U.S. application is a national stage application of PCT application No. PCT/JP2004/008710, filed June 21, 2004, which claims priority to assigned Japanese Application No. 2003-176965. Although the Japanese priority application was not filed with a set of claims, the claims currently pending in the U.S. are found almost verbatim in the section labeled "Elements to Solve the Problem," and, specifically, paragraph [0012] – where "Item 1" corresponds to claim 1, "Item 2" corresponds to claim 2, etc. Additional specific support in the Japanese priority application for the currently pending claims in the above-identified application is laid out in the below table.

Claim	Claim Element	Support in Japanese Priority Application 2003-176965
1.	An ophthalmic composition which comprises pyridoxine hydrochloride, chondroitin sulfate salt, and cellulose based polymer compound.	See entire document, and specifically paragraphs [0010] – [0015]
2.	The ophthalmic composition according to claim 1 where said cellulose based polymer compound is at least one compound selected from hydroxyethyl cellulose, methyl cellulose, and hydroxypropyl methyl cellulose.	See paragraphs [0012] and [0015] Examples 1, 3, 4, and 5 use hydroxypropyl methyl cellulose (HPMC) (Table 1, p 14, and [0037]-[0042]) and Example 2 uses methyl cellulose (Table 1, p 14)
3.	A process for alleviating an irritation to eyes with an ophthalmic composition containing pyridoxine hydrochloride, the process comprises blending a chondroitin sulfate salt and cellulose based polymer compound together with an ophthalmic composition containing pyridoxine hydrochloride.	See paragraph [0012] Examples 1 and 2 having a chondroitin sulfate salt and cellulose based polymer compound exhibited no irritation in comparison to comparative pyridoxine hydrochloride compositions lacking these additives (cf. Table 1, Examples 1 and 2 and Relative Examples 1-6, p 14)
4.	The process for alleviating an irritation according to claim 3, wherein said cellulose based polymer compound is at least one compound selected from hydroxyethyl cellulose, methyl cellulose, and hydroxypropyl methyl cellulose.	See paragraphs [0012] and [0015] Examples 1, 3, 4, and 5 use hydroxypropyl methyl cellulose (HPMC) (Table 1, p 14, and [0037]-[0042]) and Example 2 uses methyl cellulose (Table 1, p 14)

The English translation of the priority document demonstrates that the current U.S. claims find support in the priority document that was assigned to Kobayashi and are therefore directed to the invention that is described in the Japanese priority document. Thus, inventor Matsui assigned the subject matter of the current application to Kobayashi.

To further demonstrate petitioners' proprietary interest, the assignee submits a declaration by Mr. Naonori Murakami (Appendix 5), who was Director at the Research and Development Company of Kobayashi Pharmaceutical Co., Ltd, in June 2003 (the time that the Japanese priority document was filed), and whose duties included ensuring that employees executed an oath to abide by Regulations For Employee's Invention. According

to these Regulations, once an employer decides to pursue a patent application on an employee's invention, the employer must notify the employee of such (Paragraph 5, Exhibit C of Mr. Murakami's declaration). Once the employee is notified, the inventor/employee has a duty to assign her rights to the employer (Paragraph 8, Exhibit C of Mr. Murakami's declaration). Thus, since Kobayashi decided to pursue a patent application in the invention, Ms. Matsui had an obligation to assign her rights to Kobayashi in that invention. In fact, Ms. Matsui *did* assign her rights to the invention, as the priority document of the present application (Japanese Application No. 2003-176965). Since the claims of the present application are fully supported in the priority document, and Ms. Matsui executed an oath binding her to abide by employment regulations which grant the right to her employer to pursue a patent in her, the employee's, invention, it is submitted that Kobayashi has the requisite proprietary interest in the current application and to file this petition.

The Director is authorized to charge Deposit Account No. 13-2855, under Order No. 19036/40796 for any fees due with the filing of these petitions, including any extension of time fees.

It is submitted that the assignee has shown sufficient evidence of inventor Matsui's refusal to sign an inventor's declaration and has supplied all other required documents and evidence for a petition under 37 CFR 1.47(b). It is respectfully requested that the petition under 37 CFR 1.47(b) be granted. If the Patent Office or Petitions Officer wishes to discuss this request further, s/he is invited to contact the undersigned at the telephone number listed below.

Dated: October 9, 2007

Respectfully submitted,

Signature: /Shelley C. Danek - #57,712/
Shelley C. Danek, Ph.D.

Registration No.: 57,712
MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive, Suite 6300
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Agent for Assignee

APPENDIX 1

Docket No.: 19036/40796
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Yuka Matsui

Application No.: 10/561,629

Confirmation No.: 8420

Filed: June 21, 2004 as PCT/JP2004/008710 (national
stage entry on December 20, 2005)

Art Unit: Not Yet Assigned

For: OPTHALMIC COMPOSITION

Examiner: Not Yet Assigned

DECLARATION OF FACTS FOR PETITION TO ACCEPT FILING UNDER 37 CFR
§1.47(b)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I, Naoko Harada, hereby declare as follows:

1. I am an employee of Kobayashi Pharmaceutical Co., Ltd., assignee of the above-identified application (hereafter "Assignee"), and my title is Senior Staff. I submit this Declaration to provide facts to the United States Patent and Trademark Office relating to the delivery of application papers to Yuka Matsui, sole inventor of the subject matter in the above-identified patent application, and Ms. Matsui's subsequent refusal to execute an inventor's declaration.

2. On April 30, 2006, I personally hand-delivered a copy of the above-identified patent application and an unexecuted inventor's declaration to Ms. Matsui, who was personally known to me from the time that we both worked for the Assignee. Ms. Matsui told me that she would review the papers I gave her.

3. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and

further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: August 20, 2007

Signed: Naoko Harada

Name: Naoko Harada

APPENDIX 2

Docket No.: 19036/40796
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Yuka Matsui

Application No.: 10/561,629

Confirmation No.: 8420

Filed: June 21, 2004 as PCT/JP2004/008710 (national
stage entry on December 20, 2005)

Art Unit: Not Yet Assigned

For: OPHTHALMIC COMPOSITION

Examiner: Not Yet Assigned

**DECLARATION OF FACTS FOR PETITION TO ACCEPT FILING UNDER 37 CFR
§1.47(b)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I, Yasuyo Yamaguchi, hereby declare as follows:

1. I am a Manager of Kobayashi Pharmaceutical Co., Ltd., assignee of the above-identified application (hereafter "Assignee"). I submit this Declaration to provide facts to the U.S. Patent and Trademark Office relating to the refusal of Yuka Matsui, sole inventor of the subject matter in the above-identified patent application, to execute an inventor's declaration.

2. On August 30, 2006, I had a telephone conversation with Ms. Matsui regarding the inventor's declaration that my colleague Ms. Naoko Harada hand delivered to Ms. Masui for the above-identified United States patent application. Ms. Matsui told me that she would not sign the declaration for this application.

3. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and

the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: Aug 20, 2007

Signed: Yasuyo Yamaguchi
Name: Yasuyo Yamaguchi

APPENDIX 3